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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/827,227 | 04/05/2001 | Philip D. MacKenzie | 9 | 6212 |

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Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560

EXAMINER

VAUGHAN, MICHAEL R

| ART UNIT | PAPER NUMBER |
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| 2131 | 6 |

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,227

Applicant(s)

MACKENZIE, PHILIP D. 

Examiner

Michael R Vaughan

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3,5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-20 have been examined and are pending.

Information Disclosure Statement

An initialed and dated copy of Applicant's IDS form 1449, Paper No. 3 and 5, is attached to the instant Office action.

Double Patenting

Claims 1, 3, 4, 5, 6, 7, and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 4, 5, 6, 18 of copending Application No. 09/638320. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the immediate application have all of the limitations of the copending application's claims. The dependent claims are identical. The independent claims of the immediate application, 1 and 8, only differ in that they add the limitation "*wherein any portion of a result associated with the function that is outside the group is randomized*" and the limitation "*remove the randomization of any portion of the result associated with the function that is outside the group*". All of the other limitations are claimed in the copending application. Schneier (Applied Cryptography) teaches a method of key authenticating as disclosed in the copending application. Schneier also

teaches randomizing the result on page 520 to strengthen the security of the cryptosystem. In view of this it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the teachings of Schneier within the copending application's system because it would prevent possible attacks to the system by further disguising the random numbers. It logically follows that the receiver must then remove the randomized portion to recover the intended data.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 10, 12, 13, 14, 15, and 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 4, 5, and 6 of copending Application No. 09/638320. The rejection is similar to the double patenting rejection made of immediate claims 1, 3, 4, 5, 6, and 7, the difference being that independent claim 10 disclosed an apparatus which performs the method of claim 1. One of ordinary skill in the art would be able to implement the method of claim one as an apparatus.

Claims 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18 of copending Application No. 09/638320. The rejection is similar to the double patenting rejection made of immediate claims 8, the difference being that independent claim 17 disclosed

an apparatus which performs the method of claim 1. One of ordinary skill in the art would be able to implement the method of claim one as an apparatus.

Claims 19 and 20 are likewise rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 18 of copending Application No. 09/638320. The rejection is similar to the double patenting rejection made of immediate claims 1 and 8, the difference being that independent claims 19 and 20 disclosed an article of manufacture, which performs the method of claims 1 and 8. One of ordinary skill in the art would be able to implement the method of claim one as an article of manufacture.

Claim Rejections - 35 USC ' 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-8, 10, 12-17, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Schneier (Applied Cryptography).

As per claims 1, 10, and 19 Schneier teaches a method for communication via a data network, between two parties that share a password, using a Diffie-Hellman type key exchange on a particular group to generate a shared secret g^{xy} , where g is the group generator known to both parties and x is an index known to one party and y is an index known to the other party, said group having a group operation and an inverse group operation, said method comprising the steps of (page 518): one party generating a parameter m by performing the group operation on g^x and a function of at least said password, wherein any portion of a result associated with the function that is outside the group is randomized and transmitting m to the other party, whereby the other party may perform the inverse group operation on m and said function of at least said password and remove the randomization of any portion of the result associated with the function that is outside the group, to extract g^x and further calculate said shared secret g^{xy} (page 519-520).

As per claims 8, 17, and 20 Schneier teaches a method for communication via a data network, between two parties that share a password, using a Diffie-Hellman type key exchange on a particular group to generate a shared secret g^{xy} , where g is the group generator known to both parties and x is an index known to one party and y is an index known to the other party, said group having a group operation and an inverse

group operation, said method comprising the steps of (page 518): responsive to one party generating a parameter m by performing the group operation on g^x and a function of at least said password, wherein any portion of a result associated with the function that is outside the group is randomized and transmitting m to the other party, whereby the other party may perform the inverse group operation on m and said function of at least said password and remove the randomization of any portion of the result associated with the function that is outside the group, to extract g^x and further calculate said shared secret g^{xy} (page 519-520).

As per claims 3 and 12 Schneier teaches one party is a client and said other party is a server (page 518).

As per claims 4 and 13 Schneier teaches said one party receiving g^y from said other party and generating said shared secret g^{xy} (page 513).

As per claims 5 and 14 Schneier teaches one party authenticating said other party by comparing a received value against a function of at least one of an identifier of said one party, an identifier of said other party, m , g^y , the shared secret, and the password (verifier) (page 520-521).

As per claims 6 and 15 Schneier teaches said one party transmitting a function of at least one of an identifier of said one party, an identifier of said other party m , g^y , the

shared secret, and the password (verifier), to said other party whereby the other party may authenticate said one party (page 520).

As per claims 7 and 16 Schneier teaches one party generating a session key as a function of a least one of an identifier of said one party, an identifier of said other party, m , g^y , the shared secret, and the password (page 520).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 9, 11, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier in view of Oorschot et al, here Oorschot ("One Diffie-Hellman key Agreement with Short Exponents").

As per claims 2, 9, 11, and 18, Schneier teaches selecting primes and inserting randomizing portion of a result but fails to explicitly teach wherein the particular group, denoted as $G_{p,q}$ is a sub-group of a group Z_p where p and q are prime numbers such that p equals $rq + 1$ for a value r co-prime to q , and wherein the step of randomizing any portion of a result associated with the function that is outside the group $G_{p,q}$ is

performed by computing a parameter h , randomly selected from the group Z_p , raising the parameter h to the exponent q and multiplying h^q by the result associated with the function. Oorschot teaches the particular group, denoted as $G_{p,q}$ is a sub-group of a group Z_p where p and q are prime numbers such that p equals $rq + 1$ for a value r co-prime to q , and wherein the step of randomizing any portion of a result associated with the function that is outside the group $G_{p,q}$ is performed by computing a parameter h , randomly selected from the group Z_p , raising the parameter h to the exponent q and multiplying h^q by the result associated with the function (pages 9-10). Oorschot teaches the use of strong primes and why they are safe. Oorschot also teaches how one can introduce a further exponent to improve the resilience of factoring. These steps would further increase the security of the prime numbers used in Schneier's method. In view of this it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the teachings of Oorschot within the system of Schneier because it would improve the overall security of Schneier's method by implementing proven strong primes into the cryptosystem.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R Vaughan whose telephone number is 703-305-0354. The examiner can normally be reached on M-F 7:30-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MV
Michael R Vaughan

Examiner

Art Unit 2131


AYAZ SHEIKH
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